

## **REMARKS**

The Office Action of June 21, 2007, has been considered by the Applicants. No claims are amended or cancelled. Claims 1, 4-8, and 10-34 remain pending in the Application. Reconsideration of the Application is requested.

Claims 1, 7, 12-17, 19-24, and 27-30 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ebert (GB 2151201) in view of Monte (U.S. Patent No. 5,578,336) and Brox (U.S. Patent No. 4,780,316). Applicants traverse the rejection.

Initially, Applicants note that Ebert, GB 2151201, is related to Ebert, U.S. Patent No. 4,532,126, which was previously cited as a reference. Applicants have reviewed the disclosure of these two references and note that they appear substantially similar. In order to make the record clear, Applicants would appreciate a statement by the Examiner as to what subject matter is considered to be different between the two applications that necessitated the citation of GB 2151201.

The references do not teach all features of the present claims. MPEP § 2143.03. On page 3 of the Office Action, the Examiner stated that the burden was shifted to Applicant to show that Ebert does not dry the capsule under the claimed temperature. In response, Applicants note that Ebert merely discloses drying. Ebert does not inherently or explicitly teach the claimed drying temperature (30 - 40°C) or the claimed drying time (5 hours or more). For example, one may dry at higher temperatures for short periods of time. In other words, Ebert does not teach or suggest these claim features at all. In addition, the drying temperature and time are critical to the formation of V-type crystal in the fill material. This criticality rebuts any suggestion that the claimed drying temperatures and times are obvious.

The Examiner cited Brox as teaching the storage of soft gelatin capsules under temperatures of 20°C, 30°C, and 40°C for one month as being equivalent to the aging step and as teaching that it is well known to store soft gelatin capsules under such temperatures to achieve suitable capsule shell hardness. In response, Applicants submit that Brox does not teach that storage is equivalent to aging nor that one should store capsules at such temperatures to achieve capsule shell hardness. Brox is concerned with the fact that when liquid polyethylene glycol is used as a fill, it absorbs

water from the shell and makes the shell brittle. See Column 1, lines 22-42. Brox discloses a method for solving this disadvantage by providing a shell containing sorbitol. Brox then tests the new composition to ensure that the capsules are not embrittled. As a proxy, Brox tests the hardness of the samples. Brox does not store the soft gelatin capsule in order to achieve suitable capsule shell hardness. Thus, the motivation to store the capsule at a temperature of 30-40°C for more than 5 hours is not present. One of ordinary skill in the art, looking for a drying time and temperature with which to modify Ebert, would not look to test conditions for storage to find drying times and temperatures. Applicants also note that the soft capsule of the instant claims does not necessarily have the same shell brittleness problems that Brox had, so there is no motivation to solve the same problem that Brox had in Ebert. Thus, there is no motivation to combine the references.

Applicants request withdrawal of the § 103(a) rejection based on Ebert, Monte, and Brox.

Claims 1, 4-7, 11, 12, 15-17, 19-30 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Ebert in view of Cavanak (U.S. Patent No. 5,639,724) and Brox. Applicants traverse the rejection.

The references do not teach all claim elements and there is no motivation to combine the references. In particular, there is no motivation to combine Ebert and Brox, as discussed above. Cavanak is used only to teach the fill material and does not remedy the deficiencies in Ebert and Brox. Applicants request withdrawal of the § 103(a) rejection.

Claim 10 was rejected under 35 U.S.C. 103(a) as allegedly being obvious over Ebert in view Monte or Cavanak and Nishizawa (U.S. Patent No. 4,463,024). Applicants traverse the rejection.

Claim 10 depends from claim 1. If claim 1 is not obvious, then neither is claim 10. MPEP § 2143.03; *In re Fine*. Applicants do not separately argue the patentability of claim 10. Applicants request withdrawal of the § 103(a) rejection.

Claims 1, 4-7, 11, 12, 15-17, 19, 20, 22, and 24-30 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech (U.S. Patent No. 6,027,746) in view of Cavanak. Applicants traverse the rejection.

There is no motivation to modify the references. In particular, Lech merely discloses that his capsules, when tested with a fill material that was not cacao butter, were stable for extended periods at room temperature, 30°C, 40°C, and 50°C. However, this disclosure only shows that the capsules can be stored at such temperatures. Lech does not suggest a reason why they should be stored at such temperatures. Because Lech does not provide this reason, Applicants submit that, in the words of § 2143.01, the references do not suggest the desirability of the instant claims. There is no indication that storage at high temperatures is desired and Applicants submit that the coincidental overlap of the tested storage temperatures with the claimed drying temperature is simply that, coincidence. Coincidence cannot be considered motivation. Applicants traverse the rejection.

Claims 8, 12-16, and 31-34 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech, in view of Cavanak and Katsuragi et al. (U.S. Patent No. 5,756,543).

Claims 17 and 18 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech in view of Mehta (U.S. Patent No. 5,084,278).

These two rejections are traversed together.

These rejected claims all depend from claim 1. Applicants have argued above that the references do not suggest the desirability of the instant claims. Applicants do not separately argue the patentability of these claims. Applicants request withdrawal of the § 103(a) rejection.

### CONCLUSION


For the reasons given above, it is respectfully submitted all pending claims (1, 4-8, and 10-34) are now in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

FAY SHARPE LLP

November 14, 2007  
Date

  
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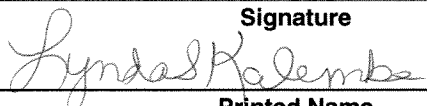
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<b>Signature</b>

<b>Printed Name</b>
<b>Lynda S. Kalembe</b>

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